

REMARKS

I. Introduction

Claims 1-44 and 46-167 are currently pending in the present application, with claims 75-86, 88-93, 96-143, and 154-161 having been withdrawn from consideration pursuant to a first restriction requirement imposed in the Office Action mailed on May 15, 2003 (“Office Action II”). Of the claims remaining for consideration, claims 1, 48, 58, 87, 94-95, 144-153, and 162-167 are independent.

The claims remaining for consideration (claims 1-44, 46-74, 87, 94-95, 144-153, and 162-167) were subjected to a second restriction requirement imposed in the Office Action mailed on August 18, 2005 (“Office Action V”). Applicants thank the Examiner for apparently withdrawing the second restriction requirement upon reconsideration, as the Examiner has rejected each of claims 1-44, 46-74, 87, 94-95, 144-153, and 162-167, and as “the Examiner has found that examining all the claims wasn’t a serious burden to the examiner.” Office Action mailed on December 1, 2005 as Part of Paper No./Mail Date 11252005 (“Office Action VI”).

All claims remaining for consideration (claims 1-44, 46-74, 87, 94-95, 144-153, and 162-167) stand rejected. In particular:

- (A) claims 166-167 stand rejected under 35 U.S.C. §112, second paragraph, for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention;
- (B) claims 1-2, 9-25, 30-31, 39-41, 43-44, 46-49, 56, 58-59, 61-62, 70, 72-74, 87, 95, 144-153, and 162-167 stand rejected under 35 U.S.C. §102(b) as being allegedly anticipated by U.S. Patent No. 5,368,129 (hereinafter “Von Kohorn”); and
- (C) claims 3-8, 26¹-29, 32-38, 50-55, 57, 60, 63-69, and 71 stand rejected under §103(a) as being allegedly unpatentable over Von Kohorn in view of various forms of “Official Notice”.

Upon entry of this amendment, which is respectfully requested, claims 1-3, 21, 48, 58, 87, 94-95, 144-153, and 162-167 will be amended to more clearly and distinctly

¹ Applicants assume that the Examiner intended to reject claims “26-29”, as opposed to claims “25-29” under §103(a), as the Examiner has already rejected claim 25 under §102(b).

point out some embodiments, and claims 4 and 22 will be cancelled without prejudice or disclaimer. No new matter is introduced by this amendment.

Applicants hereby respectfully request reexamination and reconsideration of the pending claims in light of the remarks provided herein and in accordance with 37 C.F.R. §1.112.

Further, as Applicants note that claims 42 and 94 are not addressed (*i.e.*, not rejected nor indicated as allowable) by Office Action VI, Applicants respectfully request that these claims be addressed in a subsequent non-final Office Action such that Applicants may appropriately be made aware of and/or may be capable of responding to any outstanding issues of patentability associated with these claims.

II. The Examiner's Rejections

A. Rejections Under §112, second paragraph

Claims 166-167 stand rejected under 35 U.S.C. §112, second paragraph, for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In particular, the Examiner states that claims 166-167 are indefinite because “[t]he claims do not recite what type pf [sic] technology is being used to carry out the claimed invention.” Office Action VI, pg. 2, bullet three. Applicants traverse this ground of rejection as follows.

Applicants respectfully note that there is no requirement under 35 U.S.C. §112, second paragraph, that a claim must be “a self-contained explanation of every step. That is not the role of claims. The purpose of claims is **not to explain the technology** or how it works, but to state the legal boundaries of the patent grant.” S3 Inc. v. nVIDIA Corp., 259 F.3d 1364, 1369 (Fed. Cir. 2001) (dismissing the district court’s objection “that the claims are not self-contained in that they do not explain that ‘video display information is produced by the controller’”); emphasis added.

Accordingly, Applicants respectfully request that the §112, second paragraph rejections of claims 166-167 be withdrawn.

B. Rejections Under §102(b) – Von Kohorn

Claims 1-2, 9-21, 23-25, 30-31, 39-41, 43-44, 46-49, 56, 58-59, 61-62, 70, 72-74, 87, 95, 144-153, and 162-167 stand rejected under 35 U.S.C. §102(b) as being allegedly anticipated by Von Kohorn. Applicants traverse this ground for rejection as follows.

1. The cited reference fails to teach or suggest: a qualifying action that is associated with a downstream recipient of the coupon

Applicants respectfully assert that Von Kohorn fails to teach or suggest limitations of claims 1-2, 9-21, 23-25, 30-31, 39-41, 43-44, 46-49, 56, 58-59, 61-62, 70, 72-74, 87, 95, 144-153, and 162-167. In particular, Von Kohorn fails to teach or suggest *a qualifying action that is associated with a downstream recipient of the coupon* (a limitation generally recited by each of the above-listed claims).

Von Kohorn generally describes a system to determine randomly generated payoff values for coupons and to determine random prizes to “add excitement to the shopping experience”. Von Kohorn, Abstract. In Von Kohorn, such capabilities and functionalities are likened to “well known gaming devices used in ‘slot machines’”. Von Kohorn, Col. 1, lines 66-68. Von Kohorn also contemplates utilizing the randomization process to update values of coupons.

Von Kohorn does not, however, teach, suggest, or even contemplate updating or changing the value of a coupon based on a qualifying condition associated with a **downstream recipient**. Nowhere does Von Kohorn, for example, describe multiple recipients of a coupon (such as the downstream recipients described in Applicants’ specification), much less changing a coupon’s value based on a qualification condition associated with such a downstream recipient. Von Kohorn does not, in other words, describe or contemplate multiple recipients of the same or similar coupon, much less changing the coupon’s value based on such recipients (*e.g.*, actions associated therewith).

In contrast, currently claimed embodiments describe changing a benefit of a coupon based on a qualification condition associated with a downstream recipient of the coupon. Such embodiments may provide many advantages, such as, for example, promoting “the forwarding or [other] dissemination [of] the coupons.” Applicants’

specification, pg. 2, lines 29-30. Von Kohorn simply does not teach or suggest such functionality.

Accordingly, at least because Von Kohorn fails to teach or suggest *a qualifying action that is associated with a downstream recipient of the coupon*, Von Kohorn fails to anticipate claims 1-2, 9-21, 23-25, 30-31, 39-41, 43-44, 46-49, 56, 58-59, 61-62, 70, 72-74, 87, 95, 144-153, and 162-167. Applicants therefore respectfully request that §102(b) rejections of claims 1-2, 9-21, 23-25, 30-31, 39-41, 43-44, 46-49, 56, 58-59, 61-62, 70, 72-74, 87, 95, 144-153, and 162-167 be withdrawn.

C. Rejections Under §103(a) – Von Kohorn in view of Official Notice

Claims 3, 5-8, 26-29, 32-38, 50-55, 57, 60, 63-69, and 71 stand rejected under §103(a) as being allegedly unpatentable over Von Kohorn in view of various forms of Official Notice. Applicants traverse this ground for rejection as follows.

1. Patentable Dependent Claims

Initially, claims 3, 5-8, 26-29, 32-38, 50-55, 57, 60, 63-69, and 71 are believed to be patentable at least for depending upon patentable base claims.

2. No *Prima Facie* Case of Obviousness

Further, the Examiner has simply failed to set forth a *prima facie* case of obviousness for any of claims 3, 5-8, 26-29, 32-38, 50-55, 57, 60, 63-69, and 71.

To reject claims in an application under Section 103, an examiner must show an unrebutted *prima facie* case of obviousness. *In re Rouffet*, 47 U.S.P.Q.2D 1453, 149 F.3d 1350, 1355 (Fed. Cir. 1998).

The initial burden of presenting a *prima facie* case of obviousness is upon the examiner. *In re Oetiker*, 24 U.S.P.Q.2D 1443, 977 F.2d 1443, 1445 (Fed. Cir. 1992). If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. *In re Rijckaert*, 28 U.S.P.Q.2D 1955, 9 F.3d 1531, 1532 (Fed. Cir. 1993); *Novamedix Distrib. Ltd. v. Dickinson*, 175 F. Supp. 2d 8, 9 (D.D.C. 2001).

If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. *In re Oetiker*, 24 U.S.P.Q.2D 1443, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

A reading of the rejections of claims 3, 5-8, 26-29, 32-38, 50-55, 57, 60, 63-69, and 71 reveals that the Examiner's attempt to provide a motivation to modify the reference as suggested falls far short of meeting the requirements for establishing a *prima facie* case or obviousness. The Examiner has, for example, merely provided a conclusory statement that making the proposed combinations would be advantageous, without supporting such assertions. Further, the Examiner's reliance upon bold assertions of what is allegedly "old and well known" to make up for the deficiencies of the reference fails to satisfy the burden for a *prima facie* case of obviousness. The Examiner has not, for example, supplied any evidence on the record (much less the necessary substantial evidence) to support the Examiner's assertions.

Accordingly, the Examiner has not presented a *prima facie* case of obviousness of claims 3, 5-8, 26-29, 32-38, 50-55, 57, 60, 63-69, and 71.

a) Official Notice

Further, the Examiner's rejections of claims 3, 5-8, 26-29, 32-38, 50-55, 57, 60, 63-69, and 71 are based not solely upon teachings alleged to be within Von Kohorn, but are also based in part on unsupported general assertions of what was "old and well known" before the time of Applicants' invention. Applicants respectfully traverse the Examiner's Official Notice of these recited features alleged to make up for the deficiencies of Von Kohorn.

Applicants note that the scope of the matter of which the Examiner takes Official Notice is limited to the substantial evidence in the record for such matter. No references have been provided for any of the Examiner's assertions. Given that the only particular information in the record thus far regarding what is considered to be in the prior art is the Examiner's brief statements, Applicants cannot properly determine the bounds of the prior art relied upon by the Examiner. Accordingly, Applicants dispute that the subject matter asserted was "old and well known" at the time the invention was made, and

request, for each of claims 3, 5-8, 26-29, 32-38, 50-55, 57, 60, 63-69, and 71, a reference to clarify the subject matter in more detail. See, MPEP §2144.03.

Accordingly, the Examiner's sweeping assertions cannot be used as prior art to the present application – only the content of the references of record which are prior art to the present application may so used. "[D]eficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

Further, Officially-Noted subject matter cannot be used as the basis for a rejection under 102 or 103. Official Notice may be used, if at all, only to clarify the meaning of a reference. See, e.g., *In re Ahlert*, 424 F.2d 1088 (C.C.P.A. 1969) ("Typically, it is found necessary to take notice of facts which may be used to supplement or **clarify the teaching of a reference** disclosure, perhaps to justify or explain a particular inference to be drawn **from the reference teaching**.")) (emphasis added).

In other words, Official Notice of what existed in the prior art is not permitted. A reference must be provided to show the scope and content of the prior art. See, e.g., *In re Ahlert*, 424 F.2d 1088 (C.C.P.A. 1969) ("Assertions of technical facts in areas of esoteric technology **must always be supported by citation to some reference work** recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference. ... Allegations concerning specific 'knowledge' of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge.")) (emphasis added); *In re Eynde*, 480 F.2d 1364 (C.C.P.A. 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. Facts constituting the state of the art in a patent case are normally subject to the possibility of rational disagreement among reasonable men, and **are not amenable to the taking of judicial or administrative notice**.")) (emphasis added); *In re Pardo*, 684 F.2d 912 (C.C.P.A. 1982) ("[T]his court will always **construe [the rule permitting judicial notice]** narrowly and will regard facts found in such manner with an eye toward narrowing the scope of any conclusions to be drawn therefrom. Assertions of technical facts in areas of esoteric technology **must always be**

supported by citation to some reference work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference.") (emphasis added)

Applicants therefore respectfully request that §103(a) rejections of claims **3, 5-8, 26-29, 32-38, 50-55, 57, 60, 63-69, and 71** be withdrawn.

III. Conclusion

At least for the foregoing reasons, it is submitted that all claims are in condition for allowance, or in better form for appeal, and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remain any questions regarding the present application or the cited reference, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Stephan Filipek at telephone number 203-461-7252 or via electronic mail at sfilipek@walkerdigital.com, at the Examiner's convenience.

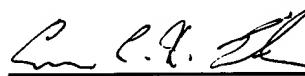
IV. Authorization to Charge Appropriate Fees & Petition for Extension of Time

Although Applicants do not believe that any fees are necessary for this response, or that any petitions for extension of time are necessary, please grant any petition for extension of time required to make this Response timely, and please charge any attendant and/or appropriate fees to deposit account 50-0271. Please also credit any overpayment to the same account.

Respectfully submitted,

March 1, 2006

Date



Carson C.K. Fincham
Attorney for Applicants
Registration No. 54,096
Walker Digital, LLC
cfincham@walkerdigital.com
203-461-7017 /voice
203-461-7300 /fax